

## REMARKS

Claims 1-11, 19-20, 41, 43, and 45-48 are pending in the application. Claims 12-18, 21-40, 42 and 44 have been canceled. Applicant respectfully requests reconsideration of the application and issuance of a notice of allowance.

### Rejections Under 35 U.S.C. § 102

Claims 1-4, 18, 41, 43, and 45 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,366,087 to Bane. Claims 1, 5, 8, 11, 19-20, 41, 43, and 45-47 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,217,307 to McClintock. The Examiner acknowledges that neither Bane nor McClintock teach that the substrate is moisture resistant, the adhesive is removable and resealable in the presence of moisture from food packaging environments, and/or that the removable adhesive has a Moist Loop Test result of at least about 0.8N/25mm at a test plate temperature of 5°C. The Examiner contends, however, that Bane and McClintock teach the same components in the laminate and, therefore, the respective laminates would inherently have all the same properties as presently claimed. Applicant respectfully traverses this rejection.

A reference fails to anticipate a claim unless the reference discloses each and every element as set forth in the claim. (MPEP § 2131.) The reference must show the identical invention in as complete detail as is contained in the claim. (Id.) To establish inherency the Examiner bears the initial burden to provide a basis in fact and/or technical reasoning to support a position that the allegedly inherent feature necessarily flows from the cited reference. (MPEP § 2112(IV).) The Examiner must show that the missing descriptive matter (i) is necessarily present in the thing described in the reference, and (ii) would be recognized by persons skilled in the art as being necessarily present. (Id.) Further, inherency cannot be established by mere possibilities or probabilities. (Id.) The fact that a characteristic may be present is not sufficient to establish inherency. (Id.)

As the Examiner acknowledges, both Bane and McClintock fail to disclose each and every element as set forth in the claims. The Examiner, however,

summarily states that Bane and McClintock teach the components of the laminate and, therefore, inherently teach the other features of the claims. But such a conclusory statement does not satisfy the Examiner's initial burden of showing that a particular characteristic is necessarily present. The Examiner has not provided any basis in fact or technical reasoning to show that the materials disclosed by Bane necessarily have the characteristics recited in the claims.

Contrary to the Examiner's allegation, Bane does not teach "the same components" in the laminate. Bane does disclose in column 3, beginning at line 56 that the adhesives 14 and 15 may be selected from a wide variety of "conventional permanent and repositional adhesives." This general disclosure, however, does not provide evidence that all conventional repositional adhesives necessarily have a Moist Loop Tack as recited in the claims. Moreover, disclosing specific examples of adhesives does not provide a reasonable basis in fact that such materials necessarily have a particular property. But even if a conventional repositional adhesive could have a Moist Loop Tack of 0.8N/25mm at 5°C, mere possibilities are not sufficient to establish inherency.

Similarly, the Examiner has failed to establish that McClintock inherently discloses the claimed features. McClintock discloses that the adhesive may be "any of the well known types such as pressure sensitive adhesive of the acrylic removable or permanent type or emulsion permanent or removable rubber based permanent and emulsion removable." (Col. 7, lines 38-43.) The Examiner, however, has not provided any evidence or technical reasoning to show that an acrylic removable adhesive or other type of removable necessarily has a particular Moist Loop Tack. McClintock's disclosure states that an adhesive based on a particular type of polymer, e.g., acrylic, may be provided as a permanent or removable adhesive. This demonstrates that an adhesive containing a particular component does not necessarily exhibit a certain property or characteristic such as, for example, a particular tack.

Consequently, Bane and McClintock fail to anticipate the claims because they fail to either expressly or inherently teach all the elements as recited in the claims. Further, the Examiner has not met the initial burden of demonstrating that Bane and McClintock necessarily teach certain features such as a moisture

resistant substrate or a removable adhesive having a particular Moist Loop Tack. Applicant respectfully requests that the rejections under § 102(b) be withdrawn.

**Rejections Under 35 U.S.C. § 103(a)**

The Examiner rejected various claims under 35 U.S.C. § 103(a) based on Bane or McClintock in combination with U.S. Patent No. 4,543,139 to Freedman et al. or WO 00/46316 to Van Driesten et al. Claims 5-7 were rejected based on Bane in view of Freedman; claims 2-4 and 6-7 were rejected based on McClintock in view of Freedman; claims 5-11, 19-20, and 46-48 were rejected based on Bane in view of Van Driesten; and claims 2-4, 6-7, and 9-10 were rejected based on McClintock in view of Van Driesten. The Examiner contends that Freedman teaches adhesive tapes with a substrate that is polymer coated paper or a polymer such as polypropylene and polyesters including polyethylene terephthalate and that it would be obvious to use such substrates. The Examiner contends that Van Driesten teaches an adhesive article with a face construct that may be made of paper and plastic film of a polyolefin such as polyethylene and polypropylene, or a polyester such as polyethylene terephthalate, and a pressure sensitive adhesive layer and non pressure sensitive adhesive layer that may be hot melt adhesive and rubber-based or acrylic-based. Applicants respectfully traverse these rejections.

Combining Bane or McClintock with either Freedman or Van Driesten fails to render the claims obvious. As discussed above, neither Bane nor McClintock teach or suggest all the features recited in the claims. And neither Freedman nor Van Driesten make up for the deficiencies of Bane and/or McClintock.

Freedman et al. relates to a structure having adjoining pressure sensitive adhesive strata, where the outermost strata has a different adhesion to a substrate. While Freedman may teach that particular materials may be used as the substrate, the Examiner has not provided any technical reasons why such materials are necessarily moisture resistant. Further, even though Freedman may employ removable adhesives, the Examiner has not provided any basis in fact or technical reasoning as to why such removable adhesives necessarily have a Moist Loop Tack as recited in the claims.

Van Driesten is directed to a dry peel label that includes a non-PSA layer. Even though Van Driesten may teach particular materials as being suitable for use in the non-PSA layer, Van Driesten does not teach or suggest that such materials have a particular tack and also fails to provide any indication that such materials would necessarily have a particular tack value.

Again, the fact that a particular material could have a particular characteristic is not sufficient to establish inherency. Rather, the Examiner must provide a basis in fact or technical reason that the missing characteristic is necessarily present and could be recognized by persons skilled in the art as being necessarily present.

Consequently, the claims are not obvious in view of either Bane or McClintock alone or in combination with either Freedman or Van Driesten. Applicant respectfully requests that the rejections under § 103(a) be withdrawn.

### CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests a timely issuance of a Notice of Allowance for claims 1-11, 19-20, 41, 43, and 45-48.

In the event any fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to our Deposit Account No. 18-0988 under Attorney Docket No. AVERP3447USA.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP

By /Heidi A. Boehlefeld/  
Heidi A. Boehlefeld, Reg. No. 34,296

1621 Euclid Avenue  
Nineteenth Floor  
Cleveland, Ohio 44115  
(216) 621-1113